



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,416	09/05/2003	Billy Franklin Beasley JR.	31599/260254	7566
826	7590	01/19/2007		
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER CORDRAY, DENNIS R	
			ART UNIT	PAPER NUMBER
			1731	
			MAIL DATE	DELIVERY MODE
			01/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/656,416

Applicant(s)

BEASLEY ET AL.

Examiner

Dennis Cordray

Art Unit

1731

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 1/4/2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-22.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). ____
13. ☒ Other: See Continuation Sheet.

Continuation of 13. Other: Applicant's arguments, see pp 3-5, filed 1/4/2007, with respect to the rejection of Claims 1-2, 4-6, 8 and 13 under 35 U.S.C. 103(a) over Clapp have been fully considered and are persuasive. While the reference discloses sawdust having particle sizes overlapping the claimed range, Clapp teaches that the sawdust is less finely ground than wood flour and that the results obtained in making a product using sawdust are not quite as satisfactory as when using wood flour (p 2, lines 64-79). As Applicant argues, one of ordinary skill in the art would have been directed to the smaller particle size wood flour rather than to sawdust. The rejection has been withdrawn.

Applicant's arguments with regard to the McGowan reference have been fully considered but they are not persuasive.

Applicant admits on p 5 (see Figure B and explanation thereof) that the McGowan discloses using sawdust having a particle size range that substantially overlaps the claimed range. Applicant argues on pp 5-6 that McGowan is directed to tissue and writing paper and the problem of digesting sawdust to extract fibers of sufficiently long length to produce tissue paper having an acceptable total strength factor (TSF). Applicant further cites from McGowan that it is "the length of the wood fibers of the pulp that largely determines the strength of the paper." Applicant argues that, in removing the wood flour and fines from the sawdust, McGowan teaches that the larger sawdust particles are preferred. Applicant concludes that McGowan does not teach making a tissue paper using sawdust having the claimed particle size range.


While McGowan exemplifies tissue and writing paper in the discussion of the disclosed invention, the invention is directed more generally to utilization of a greater proportion of sawdust in paper production (col 2, lines 6-16) and it would have been obvious to one of ordinary skill in the art to use sawdust in the manufacture of any kind of paper, including paperboard. McGowan teaches that many types of paper are produced from wood pulp, including newspaper, wrapping paper, tissue, writing paper, cardboard and others and that the strength required in paper depends on the use of the paper (col 1, lines 25-36). For instance, tissue paper and writing paper do not require the strength of newspaper and wrapping paper, and tissue paper must tear easily (low strength) in some applications.

The only size criteria recited by McGowan for the portion of sawdust usable in papers is that the particle size fraction separated by the number 3 and 12 screens (about 1590 to 6000 micrometers) provides substantial TSF value, while smaller particle sizes do not provide perceived TSF value (col 4, lines 51-56). One of ordinary skill in the art at the time of the invention would find it obvious from the disclosure of McGowan to select sawdust having a particle size range within the disclosed range to obtain the strength benefits therefrom. One of ordinary skill in the art would also have been able to determine the strength requirements for the paper being manufactured and adjust the selected sawdust particle size for the required strength to match the use of the paper, including a particle size or size range entirely within the claimed range.

In addition, the instant Disclosure does not provide a comparison of the properties of the claimed paperboard with paperboard made using particle sizes outside of the claimed ranges, only comparisons between the instant invention and paperboard having no sawdust. There is no evidence showing that the particular claimed range is critical or achieves unexpected results relative to the prior art range.

Applicant argues on pp 6-7 that the additional references cited do not remedy the supposed deficiencies of McGowan. The argument is moot since the McGowan reference has been shown to teach the obviousness of the claimed particle size range. Applicant also argues on p 7 that the combination of six references to reject Claims 19-22 is impermissibly based on hindsight. The argument has been addressed in the prior Final Office Action by showing that the references teach only knowledge which was within the level of ordinary skill at the time the claimed invention was made and do not include knowledge gleaned only from applicant's disclosure.

The rejections are maintained.



ERIC HUG
PRIMARY EXAMINER